

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIANA MUNTEANU
And KUO-HSING HWANG

Appeal No. 2004-0813
Application 09/702,667

ON BRIEF

MAILED

APR 14 2004

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before WARREN, OWENS and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.196(a) (2003); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 1, Feb 2003; 1200-29 – 1200-30).

Appealed claim 1, and appealed claims 2 through 6, 8 and 9 dependent thereon, define the claimed magnetic recording medium as comprising at least two magnetic layers. In these claims, the magnetic material in each of the specified magnetic layers is defined either by a property thereof, as in claim 1, or by the elements that make up the magnetic material, as in claims 2 and 3.

However, appealed independent claim 7 is drafted differently and reads as follows:

7. A magnetic recording medium comprising:
a non-magnetic substrate; and
means for achieving a high SMNR, narrow half-amplitude pulse width, high resolution
and high magnetic saturation.

In giving the terms of appealed claim 7 the broadest reasonable interpretation consistent with the written description in appellants' specification as it would be interpreted by one of ordinary skill in this art, *see In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994) (*in banc*); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), we determine that the subject claim language specifies the function of the "means" as "for achieving a high SMNR, narrow half-amplitude pulse width, high resolution and high magnetic saturation," and does not define a structure which satisfies that function.

Thus, the claim language of appealed claim 7 falls within the requirements of § 112, sixth paragraph. *See Texas Digital Systems, Inc. v. Telegenx, Inc.*, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822-23 (Fed. Cir. 2002), and cases cited therein. Accordingly, the "means" language must be construed as limited to the "corresponding structure" disclosed in the written description in the specification and "equivalents" thereof. *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850. The "corresponding structure" is that "structure in the written description necessary to perform that function [citation omitted]," that is, "the specification . . . clearly links or associates that structure to the function recited in the claims." [Citation omitted.] *Texas Digital Systems, supra*. "[A] section 112, paragraph 6 'equivalent[]' . . . [must] (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. [Citations omitted.]" *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000).

We fail to find in the record where the examiner has determined the "corresponding structure" disclosed in the written description in the specification and "equivalents" thereof with respect to appealed claim 7. Thus, in the absence of the examiner's determination in these respects, the basis for the rejection of appealed claim 7 under 35 U.S.C. § 102(b) as anticipated by Ohkijima et al. as evidenced by appellants' admissions with respect to the prior art (answer,

pages 5-7), and under 35 U.S.C. § 103(a) as being unpatentable over Moroishi et al. in view of Miyazaki et al. and Zhang et al. (answer, page 8-9) is not apparent from the record.

Merely including the invention encompassed by appealed claim 7 in the consideration of the layered material in which each of the specified magnetic layers has one different specified property limitation as defined in appealed claim 1 (*see* the first full paragraph on each of pages 6 and 8 of the answer), is not a substitute for the determination of the “corresponding structure” disclosed in the written description in the specification and “equivalents” thereof with respect to the claimed magnetic recording material specified only in terms of characteristics required in the “means” clause of claim 7, and the comparison of such determined “corresponding structure” and “equivalents” thereof with the prior art and admissions applied by the examiner under the two statutory provisions. Indeed, it appears from the record that the two claims may be of different scope.

We point out in this respect, that while the examiner and appellants (*see* brief, page 4) have argued the above grounds of rejection based on appealed claim 1, our consideration of this appeal is not so limited. *See* 37 CFR § 1.196 (2003).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to interpret appealed claim 7 under the requirements of § 112, sixth paragraph, and to thus apply prior art thereto, including the prior art of record and appellants’ admissions with respect to the prior art relied on in this appeal as well as any other prior art which the examiner may develop, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

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McDermott, Will & Emery
600 13 Street NW
Washington, DC 20005-3096